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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,504	01/25/2002	John H. Westerbeke JR.	00637-031001	4878
26161	7590	10/14/2003	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			ELKASSABGI, HEBA	
		ART UNIT	PAPER NUMBER	
		2834		

DATE MAILED: 10/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/057,504	WESTERBEKE, JOHN H.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Heba Elkassabgi	2834	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-34 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-34 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                          | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                 | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8 and 14-17 and 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Grinde (4836123).

Grinde discloses in fig. 1-11 a power generator comprising in a marine motor: a four-stroke water-cooled engine (52) with a vertically – oriented drive shaft (64) and an alternator (54) with a vertically oriented rotor coupled for rotation with the engine drive shaft to produce electricity and laterally spaced from the engine shaft; and transporter frame 17 (admits air only for combustion) coupled to the engine and alternator mounted in side-by side with an outlet power. Wherein, the generator is mounted inside a boat hull (58), with an exhaust system of the engine including an exhaust (38) riser extending above a water line. Grinde also disclose a platform (14) for securing the generator and a seawater pump (56) coupled to the shaft at an opposite end of the engine that a pulley (92) driving the alternator. Wherein, the engine is cooled by a circulated coolant (seawater) cooled in a liquid heat exchanger (26) and injected into the exhaust system.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-13,18-19 and 24-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grinde in view of Rustedki (4007387).

Grinde substantially discloses all the claim features in figs.1-11. However, Grinde does not disclose the rotor having permanent magnets attached to an inner circumferential surface of the rotor. Wherein, the weight and position of the magnets are selected to balance firing impulse and radial acceleration of the engine and it's rotating components and a stationary stator responsive to the moving magnetic fields generated by the rotor and package with in the engine drive.

Rustedki teaches in fig.1-2 a generator comprising: a rotor (fig.1) having permanent magnets (27) attached to an inner circumferential surface of the rotor. Wherein, the weight and position of the magnets are selected to balance firing impulse and radial acceleration of the engine and it's rotating components and a stationary stator fig.6 (50) responsive to the moving magnetic fields generated by the rotor and package with in the engine drive for the purpose of producing high output at low speed when functioning as an alternator. The method is inherent based on the structural limitations of the claims. Therefore it would have been obvious to one having ordinary skill in art at the time the invention was made to modify the generator of Grinde with the teaching of Rustedki for the purpose to of producing a high output.

Also it would have been an obvious matter of design choice to design to reduce the size of the generator to less than 20 inches, since such a modification would have

involved a mere change in the sized of a component. A change in sized is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955)

Referring to claims 14

It has been held that the recitation that an element is "adapted to" to perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen B Addison whose telephone number is 703-306-5855. The examiner can normally be reached on 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on 703-308-1317. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

HYE  
9/26/03

*Thomas M. Dugherly*  
J